

REMARKS

Claims 1-46 are pending in this application. Claims 1, 23 and 46 have been amended. Claims 3-4 and 35-36 have been canceled. No new matter is believed to be added by this response. All amendments are supported by the specification (see paragraphs [0030]-[0035], page 3 of that specification), and as such should not require a new search. Applicants submit that all of the claims are now in a form for allowance.

Claim Rejections – 35 U.S.C. § 102

In the Office Action, claims 1-3 and 5-22 were rejected under 35 U.S.C. 102(b) as being anticipated by Shoff et al. (US 6,240,555). Claim 1 is an independent claim from which claims 2-22 depend either directly or indirectly.

A proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). The test is the same for a process. Anticipation requires identity between the claimed process and a process of the prior art. The claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. *See, e.g., Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc.*, 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995). Those elements must either be inherent or disclosed expressly. *See, e.g., Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). In summary, the single prior art reference must properly disclose, teach or suggest each element of the claimed invention. Moreover, “every element of the claimed invention must be literally present, arranged as in the claim. ... The identical invention must be shown in as complete detail as is contained in the patent claim.” *See, e.g., Richardson v. Suzuki Motor Company Co.* 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Applicants submit that every feature of the above-identified amended claims is not present in Shoff.

1. Independent Claim 1

Amended Claim 1 of the present application provides as follows:

1. A method comprising:

receiving from a remote location trigger attribute data identifying at least one display attribute of an interactive icon, **wherein the trigger attribute data is comprised of a portion that complies with an ATVEF (Advanced Television Enhancement Forum) standard and a portion that is not defined by an ATVEF standard;**

responsive to receiving the trigger attribute data, causing an interactive icon having the at least one attribute identified by the trigger attribute data to be displayed via a display device;

receiving user input selecting the interactive icon; and

responsive to receiving the user input, providing a television presentation enhancement. (Emphasis in bold added.)

Applicants respectfully request that the rejection of independent claim 1 be withdrawn for at least the reason that Shoff fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 1. Specifically, the Office action admits that “Shoff et al fail to disclose wherein the trigger complies with an ATVEF (Advanced Television Enhancement Forum) standard.” (Office Action, page 10.) Furthermore, applicants submit that Shoff et al. fails to disclose, teach, or suggest “receiving from a remote location trigger attribute data identifying at least one display attribute of an interactive icon, wherein the trigger attribute data is comprised of a portion that complies with an ATVEF (Advanced Television Enhancement Forum) standard ***and*** a portion that is not defined by an ATVEF standard” (emphasis in bold italics added) as is now found in amended claim 1.

Shoff et al. discloses:

If the program is interactive compatible (i.e., the "yes" branch from step 154), the viewer computing unit retrieves the target specification from the EPG data structure (step 158 in FIG. 6). *The target specification might be a pointer to a memory location at the headend, or a pointer to a memory location on a locally running CD-ROM, or a hyperlink to a target resource located at an independent service provider.* The hyperlink browser 106 is loaded onto the processor to render the target resource referenced by the target specification (step 160).

(Shoff et al. at Col. 9, lines 20-29, emphasis added.)

Shoff does not disclose or teach target attribute data that is comprised of ATVEF compliant and ATVEF non-compliant data. Contrastingly, the specification of the present application teaches target attribute data that is comprised of ATVEF compliant and non-compliant data:

[0024] As a non-limiting example, triggers that comply with an ATVEF (Advanced Television Enhancement Forum) standard are text-based and begin with ASCII '<'. Other values for the first byte are reserved. Receivers may be configured to ignore any trigger that does not begin with the '<' in the first byte. The general format for ATVEF compliant triggers includes a URL followed by zero or more attribute/value pairs and an optional checksum:

1 <url> [attr.sub.1:val.sub.1][attr.sub.2:val.sub.- 2] . . .
[attr.sub.n:val.sub.n][checksum]

And:

[0030] According to one embodiment, a trigger may also include one or more of the following attribute/value pairs that are not defined by an ATVEF standard:

Even assuming, *arguendo*, that Shoff et al. discloses trigger attribute data that is not complaint with the ATVEF standard, Shoff et al. does not disclose or teach trigger attribute data that is comprised of a portion that complies with an ATVEF (Advanced Television Enhancement Forum) standard and a portion that is not defined by an ATVEF standard as is now claimed in amended claim 1.

For at least the reasons described above, Shoff et al. fails to disclose, teach or suggest all of the features recited in claim 1. Therefore, Applicants respectfully submit that the rejection of claim 1 be withdrawn.

Furthermore, Applicants respectfully submit that trigger attribute data comprised of a portion that complies with an ATVEF (Advanced Television Enhancement Forum) standard and a portion that is not defined by an ATVEF standard is not made obvious over Shoff et al. or over Shoff et al. in view of other art cited in the Office Action (e.g., Heer, Martinolich, etc.) as these references, alone or in combination, fail to teach, suggest or make obvious this limitation.

2. Claims 2-3 and 5-22

Applicant respectfully requests to cancel claim 3, without prejudice. Because claim 1 is allowable over Shoff et al., dependent claims 2 and 5-22 are allowable as a matter of law for at least the reason that at each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of claims 2 and 5-22 be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 23-35 and 37-45 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Shoff et al. in view of Heer et al. (US 2005/0097600).

Claims 4, 36 and 46 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Shoff et al. in view of Martinolich et al. (US 2006/0136982).

Applicants respectfully request to cancel claims 4, 35 and 36, without prejudice.

Applicants first submit that, for a *prima facie* case of obviousness, the cited prior art references (when combined) “must teach or suggest all the claim limitations” MPEP § 2143. Thus, if the combination of references does not teach each of the claimed limitations, a finding of obviousness fails. In addition, the Patent Office has the burden under § 103 to establish a *prima facie* case of obviousness, which can be satisfied only by showing some objective teaching in the prior art would lead one to combine the relevant teachings of the references. *See In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). As such, an Applicant, to overcome an allegation of obviousness, can show that the cited prior art references (when combined) do not teach or suggest all the claim limitations or that there is not an objective teaching in the prior art that would lead one to combine the relevant teachings of the references.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

1. Claims 23-34 and 37-45

As described above, Applicants respectfully submit that Shoff fails to disclose, teach, or suggest at least the features of a **trigger attribute data is comprised of a portion that complies with an ATVEF (Advanced Television Enhancement Forum) standard and a portion that is not defined by an ATVEF standard**, as recited in amended independent claim 23 from which claims 24-34 and 37-45 depend either directly or indirectly. The addition of Heer et al. fails to remedy these deficiencies. Since dependent claims 24-34 and 37-45 incorporate these same features found in independent claim 23, as amended, Applicants respectfully submit that claims 24-34 and 37-45 are allowable over Shoff et al. in view of Heer et al.

2. Claims 46

As described above, Applicants respectfully submit that Shoff et al. fails to disclose, teach, or suggest at least the features of a **trigger attribute data is comprised of a portion that complies with an ATVEF (Advanced Television Enhancement Forum) standard and a portion that is not defined by an ATVEF standard**, as recited in amended independent claim 46. The addition of Martinolich fails to remedy this deficiency. Applicants respectfully submit that claim 46 is allowable over Shoff et al. in view of Martinolich et al.

Second, the Supreme Court has reaffirmed the *Graham* factors for determination of obvious under 35 U.S.C. 103(a). *KSR Int'l Co. v. Teleflex, Inc.* (KSR), No 04-1350 (U.S. Apr. 30, 2007). The four factual inquiries under *Graham* require examination of: (1) the scope and contents of the prior art; (2) the differences between the prior art and the claims in issue; (3) the level of ordinary skill in the pertinent art; and (4) the objective evidence of secondary consideration. *Graham v. John Deere (Graham)*, 383 U.S. 1, 17-18, 149 USPQ 459, 467 (1966); see also 35 U.S.C. § 103 (2000).

The Court has further recognized that the requirement for a teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, which was established by the Court of Customs and Patent Appeals, provides a helpful insight for determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Where an invention is contended to be obvious based upon a combination of elements across different references, one should be able to identify particular reasons that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements. *See, KSR Int'l Co.*, at 14, 15. This requirement prevents the use of “the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” *Ecolochem, Inc. v. So. Cal. Edison Co.*, 227 F.3d 1361, 1371-72 (Fed. Cir. 2000) (quoting *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)).

Applicants submit that the current construction of the cited references in the manner provided in the Office Action requires hindsight reasoning, which the Federal Circuit has explicitly rejected. *See In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). At the time of the invention, it would not have been obvious to one of ordinary skill in the art to combine Shoff et al. in view of Heer et al. or Martinolich et al. to arrive at the present invention. Applicants earnestly request reconsideration, withdrawal of these rejections, and allowance of claims 23-34, 37-45 and 46.

Conclusion

In this response, claims 1, 23 and 46 are amended and claims 3-4 and 35-36 have been canceled. Subsequent to this response, claims 1-2, 5-34, and 37-46 remain pending. No new

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matter is believed to be added by this response. Applicants submit that all of the claims are now in a form for allowance. Thus, Applicants respectfully request allowance of all the pending claims.

No fee is believed due; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted on behalf of the Applicants,

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